

Amendments to the Drawings

The amended set of 9 drawings, attached herewith, replaces all drawings currently of record in the present application.

Request for an Extension of Time

The Applicant requests a three month extension of time under the provisions of 37 CFR 1.136(a), in which to respond to the Office Action of March 28, 2007. Payment of the requisite fee, in respect of a small entity, is included with this submission.

I confirm that I am the Agent of Record for this application.

Drawings

The drawings of record have been amended to meet the format requirements of the US Patent Office. Copies of the nine pages of drawings are attached. As such the objection to the drawings, as being informal under 37 CFR 1.84 has been obviated. No additional subject matter has been added to the drawings.

Amendments

Claims 1 to 10 currently stand of record in the present application. In response to the Office Action, the subject matter of Claims 4 and 8 have been incorporated into Claim 1, and these claims have therefore been canceled. Additionally, Claim 10 of record has also been cancelled. As such, Claims 1 to 3, 5 to 7 and 9 remain pending in the present application.

With these amendments, Claims 1 has been amended to be directed to novel subject matter, and basis for the amendments can be found in the original set of claims, and/or in the discussion found on page 9, and in particular the description of Figure 4, *et seq.* As such, no additional subject matter has been added as a result of these amendments, and all amendments are fully supported by the application as originally filed.

The dependencies of various claims have also been amended to reflect the cancellation of Claims 4 and 8.

Remarks:

In response to the objections raised in the Action, the Applicant comments as follows:

Rejection under 35 USC 112

Claims 2 to 9 currently stand rejected under 35 USC 112, second paragraph. In response, the Applicant has amended the claims to more clearly point out and distinctly claim the subject matter of the present invention.

In particular, Claims 2 to 7 and 5 to 9 have been amended to replace, where necessary the term “or” or “includes”. Where possible, the claims have been amended to claim the relevant subject matter using Markush expressions.

As to Claim 2, the types of computerized devices are specifically listed. Basis for stand alone and laptop computers can be found at page 3, line 28 of the original application.

With respect to Claim 3, the word “includes” is not used in the claim. However, the claim has been amended to follow the Markush expression format.

Claim 5 has been amended to remove the phrase “and/or”.

Claims 6 and 7 have also been amended to follow the Markush expression format, and thus obviate the objections to these claims.

Claim 8 has been canceled, and the objection to Claim 9 has been amended by limiting the scope of the claim.

With these amendments, the objections to the claims under 35 USC 112 have been obviated.

Rejection under 35 USC 101

Claim 10 stands rejected as being directed to non-statutory subject matter. In response, the Applicant has cancelled Claim 10, and thus, this objection has also been obviated.

Rejections under 35 USC § 102

With respect to objections under 35 USC 102, the Applicant notes the following points concerning anticipation. First, in reference to anticipation, the Court of Customs and Patent Appeals, in *In re Wilder*, said the following:

Simply stated, a prior publication or patent description will be considered as anticipatory when its disclosure is at once specific and enabling with regard to the particular subject matter at issue. . . . However, such disclosure may yet be held not to legally anticipate the claimed subject matter if it is found not to be sufficiently enabling, in other words, if it does not place the subject matter of the claims within "the possession of the public."

[*In re Wilder*, 166 USPQ 545, 548 (C.C.P.A. 1970)]

Further, in 1980, in *In re Donohue*, the same court said:

For a publication to constitute an anticipation of an invention and, thus, to bar the grant of a patent under 35 USC 102, it must be capable, when taken in conjunction with the knowledge of those skilled in the art to which it pertains, of placing that invention in the possession of the public.

[*In re Donohue*, 632 F.2d 123, 207 USPQ 196 (C.C.P.A. 1980); referred to in *Ex parte Humphreys*, 24 USPQ 2d 1255, 1261–62 (B.P.A.I. 1992)]

There are numerous other decisions, as well, which establish that in order for a publication to be considered as a prior art reference under 35 USC § 102, it must be enabling, and it must disclose the entire invention. See, for example, *Ciba-Geigy Corp. v. Alza Corp.*, 37 USPQ 2d 1337, 1341 n.3 (Fed. Cir. 1995) (unpublished)

which states:

An anticipatory reference must be enabling, *see Akzo N.V. v. United States Int'l Trade Comm'n*, 808 F.2d 1471, 1479, 1 USPQ 2D (BNA) 1241, 1245 (Fed. Cir. 1986), *cert. denied*, 482 U.S. 909, 96 L. Ed. 2d 382, 107 S. Ct. 2490 (1987), so as to place one of ordinary skill in possession of the claimed invention. *In re Spada*, 911 F.2d 705, 708, 15 USPQ 2d (BNA) 1655, 1657 (Fed. Cir. 1990); *see Seymour v. Osborne*, 78 U.S. 516, 555, 20 L. Ed. 33 (1870) ("The knowledge supposed to be derived from the publication must be sufficient to enable those skilled in the art or science to understand the nature and operation of the invention.").

Before discussing the Section 102 rejections of the present Action in any detail, and the amendments which have been made in an attempt to overcome certain rejections and comments made by the Examiner, the Applicant considers it necessary and worthwhile to discuss the invention, and the manner in which the invention is taught and claimed

In general, it must be asked what does the present invention provide? The invention provides a method for a user to identify and save actual copies of the documents and/or other information that the user deems to be desirable, for whatever reason, to a user defined storage system. A key feature of the present invention is that the actual highlighted information that the user wishes to save, is always saved to a user defined database. This is important since it ensures that the user always has the option of retrieving the exact information that was first found. In a situation where a web page, or some other document has been amended, updated, or even removed, the user always has the capability of retrieving the document as first observed and saved.

The document saved can be any of a variety of document types, such as web page images, word processing documents, spreadsheets, and the like. In all cases, the relevant information of interest to the user is stored in the user defined database, and thus is always observable.

A second key feature is that the user defined database is, by definition, always under the control of the user since it is the user's defined database. This means that only the user would normally be able to delete the content. This is done by ensuring that the data is stored in a location which is separate from the original data. For example, a web page would be downloaded and saved on the user's computer, a local device connected to the user's computer, a remote device such as a local server, a network device such as a storage device for a local network, an Internet storage device but by necessity, a storage device different from the original web page, or a storage device or system provided by an Application Service Provider.

Again, however, it is essential that the document be stored in the user defined storage device, and stored in a manner that the user has access to the original or updated information.

In order to achieve this, the Applicant provides a simple, convenient approach to saving documents of interest to a user.

Turning now to the cited prior art, it is noted that Claims 1 to 10 stand rejected under 35 USC 102(b) as being anticipated by US Patent Publication No. 2002/0069218 (hereinafter “Sull”). The Applicant respectfully traverses this rejection particularly in view of the amendments made herein.

Sull provides a wide ranging document which describes a number of different features. In particular, though, Sull provides a method for retrieving multimedia information from the original source.

The Examiner comments that Sull stores the relevant document in a user defined data structure which the Examiner equates to the “bookmarked position” described with respect to Figure 12 of Sull. The Applicant has amended Claim 1 to clarify that the Applicant stores a copy of the actual document, rather than just providing a bookmarked position. The disadvantage of Sull’s approach of using bookmarked positions is that if a bookmarked document has been modified or even removed, then the user will be unable to access the original information. As such, saving bookmarked position information does not provide the same features as the present invention.

As such, Claim 1 is clearly not anticipated by Sull since Sull does not provide a method where all documents are stored separately from the original source document, and wherein, the original document can be compared to any updated or modified documents.

Accordingly, the rejection of Claim 1 as being anticipated by Sull has been obviated by the amendments presented herein.

As to Claim 2, while this claim is directed to the use of known computerized devices, the claim is dependent on Claim 1, and therefore is also allowable.

With respect to Claim 3, it is again noted that the document types listed are all known to the skilled artisan. However, again, the claim is dependent on Claim 1, and therefore is also allowable.

The subject matter of Claim 4 has been incorporated into Claim 1, and thus Claim 4 has been canceled. In response to the Examiner’s comments regarding Sull’s use of

CD-ROM's, DVD and hard disks, however, it is noted that Sull's use of CD-ROM's, DVD's, and hard disks (described in Paragraphs 0070 and 0461) is in relation to the virtual editing of the metadata of video files to create new video file. However, the original source material is on these devices, and remains the source of the material. Thus, Sull only creates an edited copy of the multimedia files which is found, and remains, on these types of sources. By editing the metadata, Sull provides a modified version of the original document, when the source data is re-played. As such, the original content is not displayed, and if the source data is removed (for example), the saved metadata information and the like, is not sufficient to meet the needs of the present invention, if it is even usable at all.

As to Claim 5, the user notes that Sull records the URL data, or the like. However, Sull only records this information in order to be able to access the original data, and not a copy of the original data in addition to the current data found at the URL. Again, this difference can be clearly noted by asking what would happen if the original document (such as a web page) were removed. Sull's record of the URL would not provide the content which is saved and displayed in the Applicant's approach.

As to Claim 6, the Applicant notes that Sull saves his information on similar devices to those described with respect to Claim 6. However, Sull is not saving a copy of the original information, but references to the specific items. Again, the fundamental difference in approaches differentiates the present invention from Sull, and again, if the original content was removed from the Sull system, accessing the original information would not be possible.

As to Claim 7, the Applicant notes that Sull's system is useable with respect to similar information sources as found in the present invention. However, since Claim 7 is dependent on allowable Claim 1, it is also allowable.

The subject matter of Claim 8 has been incorporated into Claim 1, and Claim 8 of record has been canceled. As such, the rejection of Claim 8 has been obviated. However, with respect to the Examiner's comments, the Applicant notes that paragraphs 380 and 381 of Sull, relate to accessing data found in a pre-existing database. This is not the same as creating a database of stored information to be used in the manner of the present

invention. Again, it can be asked, if the original database of Sull were removed, would the user be able to access the desired information. The answer is clearly no.

As to Claim 9, the Applicant notes that permission based authorization system are known in the art. However, again, amended Claim 9 is dependent on allowable Claim 1, and therefore, Claim 9 is also allowable.

Claim 10 has been canceled, and thus the objection to the Claim has been obviated.

Summary

The Applicant contends that the rejections under 35 USC 102 have been obviated or rendered moot, by the amendments presented herein, or in view of the comments presented herein. As such, all of the rejections under 35 USC 102 should be withdrawn. Further, the Applicant contends that all of the amendments presented herein are fairly based on the application as originally filed, and thus do not introduce any additional subject matter.

Therefore, the Applicant respectfully contends that the present application as amended is in an allowable condition, and respectfully solicits a Notice of Allowance at the earliest opportunity.

Respectfully submitted,
Gowan Intellectual Property



Gowan Intellectual Property

1075 North Service Road West
Suite # 203
Oakville, Ontario
CANADA L6M 2G2
T: 905-827-5000
F: 905-827-5087

Per: Gerald A. Gowan

Registered Patent & Trade-Mark Agent
US Registration No. 37,041/US Client No. 58388
email: ggowan@gowanip.com

GAG:tim
encls.